

REMARKS

The Examiner has rejected Claims 11-14 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,238,385 to Harino et al. (“Harino”) in view of U.S. Patent Application Pub. No. 2006/0200013 to Smith et al. (“Smith”). The Examiner has also rejected Claims 11-14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2004/0046934 to Sponsel et al. (“Sponsel”) in view of Harino, and further in view of Smith. In addition, the Examiner has rejected Claims 17-20 under 35 U.S.C. § 103(a) as being unpatentable over Sponsel in view of Harino and Smith, and further in view of U.S. Patent No. 3,984,156 to Jernigan (“Jernigan”).

Claims 11-14 and 16-20 stand currently amended. Claims 15 and 21 stand previously canceled. Claims 11-14 and 16-20 are currently pending. The following remarks are considered by applicant to overcome each of the Examiner’s outstanding rejections to current Claims 11-14 and 16-20. An early Notice of Allowance is therefore requested.

I. SUMMARY OF RELEVANT LAW

The determination of obviousness rests on whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In determining obviousness, four factors should be weighed: (1) the scope and content of the prior art, (2) the differences between the art and the claims at issue, (3) the level of ordinary skill in the art, and (4) whatever objective evidence may be present. Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. The Examiner carries the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness and must show that the references relied on teach or suggest all of the limitations of the claims.

II. REJECTION OF CLAIMS 11-14 AND 16-20 UNDER 35 U.S.C. § 103(A) BASED, IN PART,
ON SMITH

On pages 2, 3, and 5 of the current Office Action, the Examiner rejects Claims 11-14 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Smith and various other references. These rejections are respectfully traversed and believed overcome in view of the following discussion.

The effective filing date of the current Application is December 2, 2004. Smith published on September 7, 2006. Therefore, Smith is not available under 103(a) for obviousness as either 102(a) or 102(b) prior art. In addition, the 102(e) date of Smith is the filing date of the provisional application, from which Smith claims priority, of September 7, 2004 (Smith is a continuation-in-part of Application No. 11/005,767, and is therefore not entitled to the 102(e) date of Application No. 11/005,767). See MPEP § 2136.02(II).

However, the current Application claims priority from German Patent Application No. DE 10359239.3, filed on December 12, 2003. A copy of the verified English language translation of the German priority document is enclosed in Appendix A. Therefore, since the priority date of the current Application pre-dates the 102(e) date of Smith, Smith also fails to qualify as prior art under 102(e).

Since Smith fails to qualify as prior art under any section of 35 U.S.C. § 102, Applicants respectfully assert that Examiner has failed to establish a *prima facie* case of obviousness of Claims 11-14 and 16-20. Therefore, Applicants respectfully request the Examiner remove the rejection of Claims 11-14 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2006/0200013 to Smith et al.

III. REJECTION OF CLAIMS 11-14 AND 16-20 UNDER 35 U.S.C. § 103(a) BASED ON HARINO AND SMITH

On page 2 of the current Office Action, the Examiner rejects Claims 11-14 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over Harino and Smith. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Even if Smith did qualify as prior art under 35 U.S.C. 102 (which it most certainly does not), the art cited by the Examiner would still fail to disclose the invention of Claim 11.

In particular, Claim 11 states, in part:

“moving the fixation mark in the field of vision of the patient during the treatment being carried out by the ophthalmologic treatment device....” (emphasis added).

As such, Claim 1 requires that the fixation mark is moved during the treatment being carried out. Both Harino and Smith fail to disclose this language of Claim 11.

First, it should be noted that Examiner does not assert that either Harino or Smith disclose that the fixation mark is moved during the treatment being carried out. As such, Examiner’s rejection is inherently deficient for failing to address all of the language of Claim 11.

Second, both Harino and Smith fail to disclose that the fixation mark is moved during the treatment being carried out. In particular, as can be seen in Fig. 8 of Harino, the target plate 23 is separate and distinct from the fixation target plate 63. See Harino, Col. 4, Lns. 15-16 and 32-33. The only disclosure of a movable mark in Harino relates to the target mark on target plate 23, and not to the fixation target formed on the fixation target plate 63. Harino, Col. 6, Lns. 45-46. In fact, Harino explicitly states that the fixation mark is projected for fixing the patient’s eye at a predetermined position. Harino, Col 1, Lns. 56-60. As such, Harino teaches that the fixation mark is fixed, and not movable, as stated in Claim 11.

Similarly, Smith also fails to disclose that the fixation mark is moved during the treatment being carried out. The solution described by Smith concerns maintaining the optical fixation and orientation of the eye or head relative to a measurement device for the duration of a

glucose test. With the invention suggested by Smith, routine noninvasive blood sugar measurements can be carried out which are based on determining the glucose concentration in the retina of the eye. Eye movements should be prevented for the duration of the measurement. As such, Smith fails to disclose a fixation mark that is moved during the treatment being carried out, as stated in Claim 11.

In response, Examiner asserts that paragraph [0118] of Smith discloses that the fixation mark is moved during treatment. However, the movement of the fixation target in Smith is, as admitted by Examiner, during testing, measurement, and analysis procedures. It should be noted that none of these three procedures (i.e., testing, measurement, or analysis) actually treat the eye. Rather, they analyze the eye, but never treat it. As such, the movement of the fixation target in Smith does not occur during any treatment of an eye of a patient.

This situation is similar to testing, measuring, or analyzing water for contaminants. No one would ever describe such water as being treated, as the water remains in the same condition after the testing, measuring, or analyzing. Rather, the term treated water is reserved for water whose properties (e.g., level of contaminants) has been altered. Similarly, one of ordinary skill in the art would never describe an eye as treated, where the eye was instead tested, measured, or analyzed, as the eye remains in exactly the same condition after the testing, measuring, or analyzing as it was before the testing, measuring, or analyzing.

As such, the movement of the fixation target in Smith does not occur during any treatment of an eye of a patient, as understood by one of ordinary skill in the art.

Accordingly, Applicants respectfully assert that Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 11, and corresponding Claims 12-14 and 16-20 because they are each dependent upon Claim 11. Therefore, Applicants respectfully request the Examiner remove the rejection of Claims 11-14 and 16-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,238,385 to Harino et al. in view of U.S. Patent Application Pub. No. 2006/0200013 to Smith et al.

IV. REJECTION OF CLAIMS 11-14 AND 16 UNDER 35 U.S.C. § 103(A) BASED ON SPONSEL, HARINO, AND SMITH

On page 3 of the current Office Action, the Examiner rejects Claims 11-14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over Sponsel, Harino, and Smith. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Even if Smith did qualify as prior art under 35 U.S.C. 102 (which it most certainly does not), the art cited by the Examiner would still fail to disclose the invention of Claim 11.

In particular, as stated above, Claim 11 states, in part:

“moving the fixation mark in the field of vision of the patient during the treatment being carried out by the ophthalmologic treatment device....” (emphasis added).

Thus, Claim 1 requires that the fixation mark is moved during the treatment being carried out. As discussed above, both Harino and Smith fail to disclose this language of Claim 11. Similarly, Sponsel also fails to disclose this language of Claim 11.

In particular, Sponsel relates to a measurement device and not to a treatment device. In fact, Sponsel discloses no treatment whatsoever. Thus, as with Harino and Smith, Sponsel fails to disclose a fixation mark that is moved during the treatment being carried out, as stated in Claim 11.

In addition, one of ordinary skill in the art would not combine the disclosure in Sponsel of a movable fixation mark for measurement with the disclosures of Harino and Smith of a stationary fixation mark for treatment. The treatments of Harino and Smith rely on the eye being in a fixed position, as stated above. Moving the eye during the treatments of Harino and Smith would result in improper treatment and even possibly damage to the eye. Therefore, one of skill in the art would not combine a movable fixation mark that is only taught as being useful for measurement, where there is no risk of damage to the eye during treatment, with the treatment disclosures of Harino and Smith, where there is a risk of damage to the eye during treatment.

Thus, even a combination of Sponsel with Harino and Smith would fail to arrive at the above language of Claim 11.

Accordingly, Applicants respectfully assert that Examiner has failed to establish a prima facie case of obviousness of independent Claim 11, and corresponding Claims 12-14 and 16 because they are each dependent upon Claim 11. Therefore, Applicants respectfully request the Examiner remove the rejection of Claims 11-14 and 16 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2004/0046934 to Sponsel et al. in view of U.S. Patent No. 6,238,385 to Harino et al., and further in view of U.S. Patent Application Pub. No. 2006/0200013 to Smith et al.

V. REJECTION OF CLAIMS 17-20 UNDER 35 U.S.C. § 103(A) BASED ON SPONSEL, HARINO, SMITH, AND JERNIGAN

On page 5 of the current Office Action, the Examiner rejects Claims 17-20 under 35 U.S.C. § 103(a) as being unpatentable over Sponsel, Harino, Smith, and Jernigan. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Claims 17-20 are each dependent upon independent Claim 11. As Claim 11 is allowable, so must be claims 17-20. Accordingly, Applicants respectfully assert that Examiner has failed to establish a prima facie case of obviousness of Claims 17-20. Therefore, Applicants respectfully request the Examiner remove the rejection of Claims 17-20 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Pub. No. 2004/0046934 to Sponsel et al. in view of U.S. Patent No. 6,238,385 to Harino et al. and U.S. Patent Application Pub. No. 2006/0200013 to Smith et al., and further in view of U.S. Patent No. 3,984,156 to Jernigan.

Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference

with Applicant's attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,

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Appendix A